



PATENT
Attorney Docket No. 209391

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

LEIDNER et al.

Application No. 09/828,219

Filed: April 9, 2001

For: ERASABLE COLORED PENCIL
LEAD

Art Unit: 1714

Examiner: Callie E. Shosho

COMMENTS ON THE STATEMENT OF REASONS FOR ALLOWANCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Statement of Reasons for Allowance ("the Statement") dated June 8, 2004, states that Kitazawa (USP 5,595,700) "discloses erasable colored pencil lead composition comprising filler, colorant, binder, and polytetrafluoroethylene, i.e., fibrillatable material, wherein the use of wax is not required." Applicants provide the following comments.

Applicants respectfully submit that Kitazawa does not disclose, contrary to the Statement, that the polytetrafluoroethylene is fibrillatable. Kitazawa merely discloses PTFE (polytetrafluoroethylene) powder as a water/oil repellent substance (see, e.g., col. 4, lines 7-10). It is known in the art that all PTFE powders are not fibrillatable, for example, micronized PTFE powder is not fibrillatable. Moreover, under the processing conditions set forth in Kitazawa, the PTFE powder would remain non-fibrillated, as discussed below.

The process of extruding Kitazawa's non-baked colored pencil lead involves, those of ordinary skill in the art would recognize, only moderate temperatures. For example, as set forth in Kitazawa, Example 2, water is added to a blend containing carboxymethylcellulose, talc, pigment, and PTFE powder, and the blend is mixed and dispersed. Water content is adjusted and the blend is pelleted and extruded. The extrudate is then dried to remove water. Since water is present in the extrudate (prior to drying), the extrusion process must involve only moderate temperatures. Those of skill in the art would know that presence of water in the extruder would not allow the extruder to reach high temperatures. Thus, PTFE does not undergo melt processing but merely stays as a powder. PTFE, as a powder, can act as a lubricant, which is the intended purpose of Kitazawa (see col. 4, lines 8-14, particularly "they

are excellent in lubricating properties”). This is further supported by the fact that other materials (lubricants) listed along with PTFE, namely graphite fluoride and boron nitride do not melt process under these conditions but merely blend, under Kitazawa’s conditions, as powders, as would be known to those skilled in the art. PTFE also does not melt under the drying temperature of 120° C. The foregoing shows that the PTFE powder in Kitazawa’s colored pencil lead is not in a form suitable for forming fibrils. Accordingly, the assertion that Kitazawa discloses fibrillatable material is unsupported.

Contrary to the Statement’s assertion that use of wax is not required under Kitazawa, applicants respectfully submit that Kitazawa in fact requires the use of a wax to make the non-baked colored pencil lead erasable. See, col. 4, lines 22-36:

As the oil, the fat and/or the wax with which the leads are impregnated, any one can be used, so long as it is easily permeated into the open pores, even if it is not heated up to a temperature at which the coloring agent thermally deteriorates. Examples of the oil, the fat and/or the wax include known materials, i.e., silicone oil, mineral oils, liquid paraffin, α -olefin oligomer, lard, petroleum waxes such as paraffin wax and microcrystalline wax, carnauba wax, candelilla wax, montan wax, bee’s wax, japan wax, synthetic japan wax, castor wax and stearic acid. Needless to say, they can be used singly or in combination.

In order to prepare the leads which can be erased with an eraser as easily as baked black leads for pencils, the oil, the fat and/or the wax which is liquid at ordinary temperature should be selected.

The Statement characterizes Kitazawa and JP02036281 (“JP ’281”) as the “closest” prior art. Applicants respectfully object to the use of the term “closest” as the Statement fails to explain the meaning of this term.

While Kitazawa discloses a few colored pencil lead compositions which are erasable, not all of the colored pencil lead compositions disclosed are erasable, e.g., the compositions of Examples 1-3 and 7 (Table 1). Accordingly, the assertion that Kitazawa discloses “erasable colored pencil lead compositions” is applicable only to certain of the disclosed compositions.

• In re Appln. of LEIDNER et al.
Application No. 09/828,219

Applicants respectfully submit that the claimed invention "as a whole" is not suggested by the art, including Kitazawa and JP '281.

Respectfully submitted,



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